THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAHIRO YAMANAKA

Appeal No. 1999-2370
Application No. 08/890,744[1]

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, NASE and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 25, which is the only claim pending in this application.

[1] Application for patent filed July 11, 1997.

We REVERSE.

BACKGROUND

The appellant's invention relates to a bolt. An understanding of the invention can be derived from a reading of claim 25, a copy of which appears in the opinion section below.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Sedgwick	1,389,997	Sept. 6, 1921

Claim 25 stands rejected under 35 U.S.C. § 103 as being unpatentable over Sedgwick.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 5, mailed June 25, 1998) and the answer (Paper No. 8, mailed January 28, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 7, filed

November 10, 1998) and reply brief (Paper No. 9, filed April 1, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claim 25. Accordingly, we will not sustain the examiner's rejection of claim 25 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting **evidence** that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173

USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by **evidence**, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Claim 25 reads as follows:

> A bolt (54) comprising:
> a head(541);
> a threaded section (542) concentric with the head(541) and having a diameter greater than the head (541);
> a flange (55) disposed between the head (541) and the threaded section (542), the flange (55) having a

> diameter greater than the diameter of the threaded section (542); and
>
> wherein the head (541) defines a multiple-sided tool-engaging hole (59) which extends axially into the threaded section (542).

We now turn to the examiner's rejection of claim 25. The examiner found (final rejection, p. 2) that

> Sedgwick discloses a bolt comprising a head (20) and a threaded section (27) with a flange (26) therebetween. The bolt includes a tool-engaging hole extending through both the head and threaded sections. Sedgwick discloses a head and the threaded section being the same diameter.

The examiner then determined that

> it would have been obvious matter of design choice for one of ordinary skill in the art to change the relative sizes of the bolt including wherein the threaded section is greater than the head because the relative sizes are not critical. Furthermore, a larger threaded portion would strengthen the threaded connection.

We agree with the argument of the appellant that there is no **evidence** in the applied prior art (i.e., Sedgwick) that would have suggested modifying the diameter of Sedgwick's threaded section (27) to have a diameter greater than the diameter of the head (20). Evidence of a suggestion,

teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual **evidence**. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In our view, the examiner's above-noted

obviousness determination is based on speculation unsupported by any **evidence**. Since the applied prior art would not have made the claimed subject matter obvious under 35 U.S.C. § 103 for the reason set forth above, the decision of the examiner to reject claim 25 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 25 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH Senior Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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APPEAL NO. 1999-2370 - JUDGE NASE
APPLICATION NO. 08/890,744

APJ NASE

APJ BAHR

SAPJ McCANDLISH

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 20 Dec 99

FINAL TYPED:

Gloria: Note panel changed